No. 94-2081

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1994

UNITED STATES SURGICAL CORPORATION,

Petitioner,

—v.—

ETHICON, INC. and JOHNSON & JOHNSON HOSPITAL SERVICES, INC.,

Respondents.

ON A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

Respondents Ethicon, Inc. and Johnson & Johnson Hospital Services, Inc. (collectively, "Ethicon") submit this brief in opposition to U.S. Surgical's Petition for a Writ of Certiorari.

STATEMENT OF THE CASE

The summary affirmance in this case did not announce a new or important or aberrant rule of law. It does not conflict with decisions of any other circuit court of appeals or the highest court of any state. It cannot be cited or followed

in any other case. It does not have any consequences beyond its effect on these parties. In short, there is nothing about it that it merits this Court's review.

U.S. Surgical seems to recognize this. Its petition tries to bootstrap this case to a different and unrelated case, which it believes is more worthy of certiorari than this one. But regardless of whether certiorari ought to be granted in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (*en banc*), there is no reason to grant it here.

As part of its bootstrap argument, U.S. Surgical tries to portray this case and *Markman* as raising the same issue. But the issue in *Markman* -- whether construction of patent claims is a fact issue for the jury or an issue of law for the court -- is not fairly presented by the facts of this case, and it had no impact on the outcome here.

U.S. Surgical's petition never addresses the impact, if any, that the issue presented by *Markman* had on the outcome of this case. Its petition studiously ignores the claim construction that U.S. Surgical advocated at trial. It also ignores the interplay between U.S. Surgical's claim construction and obviousness. These omissions are telling. When one addresses these issues instead of ignoring them, it is clear that the issue of who construes the claims had nothing to do with the result here.

At trial, U.S. Surgical asked for the broadest claim construction possible. It did this in order to maximize its chances of proving infringement. But U.S. Surgical's broad construction was a two-edged sword; it was also the construction most likely to lead to a finding that its patents were invalid for obviousness. Even without an instruction directing it to U.S. Surgical's broad construction of the claims, the jury found at the end of a four-week trial that U.S.

Surgical's claimed invention would have been obvious to a person of ordinary skill in the art. This finding would only have been all the more inevitable if the trial judge had directed the jury to U.S. Surgical's broad construction of the claims.

1. Background

The patents at issue in this case covered a surgical instrument known as an "endoscopic multiple clip applier. "

Endoscopic surgery is performed without major incisions, by inserting long, sealed instruments through narrow tubes or "cannulas" into a body cavity that has been inflated with carbon dioxide gas. The prior art included endoscopic versions of many surgical instruments, such as graspers, forceps, and scissors. Of necessity, the endoscopic versions of these instruments were always long and sealed.

Clip appliers are used in surgery to "ligate," or tie off, blood vessels and other anatomical structures. *Multiple* clip appliers can deliver one clip after another without reloading, the way an ordinary office stapler can deliver one staple after another. Multiple clip appliers have been used in surgery for many years, and were well-known in the prior art.

2. U.S. Surgical's Claim Construction

U.S. Surgical's claims could be construed in two ways. They could be read narrowly, as covering the particular instrument that U.S. Surgical developed and disclosed in its patents. Or they could be read broadly, as covering *any* endoscopic multiple clip applier with standard generic features for such an instrument. The narrower reading would not cover Ethicon's markedly different device. So U.S. Surgical made a tactical decision to try to preempt the entire field by advocating the broadest possible construction of the claims.

As U.S. Surgical construed the claims, its invention combined two well-known ideas from the prior art. The invention, as U.S. Surgical construed the claims, was simply an ordinary, generic multiple clip applier that was modified for endoscopic surgery by adding two features -- a long shaft and a seal.

U.S. Surgical's own experts admitted this. Thus, U.S. Surgical's expert on patent law testified that ordinary prior art clip appliers would "constitute" the claimed invention if they merely were "sealed and had a long shaft." (A 455; Tr. 1533-35). U.S. Surgical's technical expert agreed. (A 386; Tr. 1157). Thus, U.S. Surgical's experts conceded that a long shaft and a seal were the *only* points of difference between ordinary multiple clip appliers and the claimed invention.

3. The Interplay Between U.S. Surgical's Claim Construction And Obviousness

This concession had devastating implications for U.S. Surgical on the issue of obviousness. That was because a long shaft and a seal were well-known, obvious requirements for *any* endoscopic instrument.

The instruments used to perform endoscopic surgery need to be -- and always have been -- long (in order to reach a relatively distant operative site) and sealed (so that gas does not escape from a body cavity that has been inflated with carbon dioxide). U.S. Surgical admitted this right in the text of its patents, when it stated that endoscopic instruments "must be sealed so as to prevent gas leakage . . . [and] sufficiently long to reach the desired organs or tissue." (A 143, 169). This was well known for decades.

Because endoscopic instruments have always been long and sealed, U.S. Surgical's broad claim construction

turned the inquiry on obviousness into a question that answered itself: whether a person of ordinary skill in the art who wanted to adapt a multiple clip applier for endoscopic surgery would have found it obvious to include two standard features of all endoscopic instruments, *i.e.*, a long shaft and a seal.

4. Testimony Of U.S. Surgical's Experts On Obviousness

U.S. Surgical's broad claim construction put its experts in an untenable position when Ethicon raised the defense of obviousness. Saddled with that broad construction, U.S. Surgical's technical expert chose to deny something that was apparent to everyone in the courtroom: that it would have been obvious for an endoscopic instrument to have a long shaft and a seal. Thus, the expert testified as follows:

> Q: We have [an ordinary prior art multiple clip applier] . . . and somebody comes to you and says, gee, can we make the device endoscopic? You are saying it's not obvious to make the device long, cylindrical and sealed?
>
> A: [That's] exactly what I'm saying.

A 647 (Tr. 2585).

The denial by U.S. Surgical's expert that an endoscopic instrument obviously should be long and sealed ran counter to all the evidence. It was completely incredible. Endoscopic instruments, of necessity, were *always* long and sealed. That was not in dispute. The jury could see this for itself, simply by looking at the large collection of prior art endoscopic instruments -- all of them long and sealed -- on display in the courtroom. U.S. Surgical's expert, however, chose to give this

incredible testimony because his only alternative was to concede the obviousness of the invention under U.S. Surgical's broad construction of the claims.

5. The Trial Court's Instructions

In its proposed jury instructions, U.S. Surgical asked the district judge to place his imprimatur on its broad construction of the claimed invention as a long, sealed version of a generic multiple clip applier. The judge refused to do so because the underlying facts were sharply disputed. Following then-controlling Federal Circuit precedent,[1] the district judge instead submitted claim construction to the jury, along with the issues of infringement and obviousness. The judge gave the jury extensive, accurate instructions on all of these issues, including careful and correct instructions on how the jury should go about construing the claims.

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[1] *See, e.g., Delta-X Corp v. Baker Hughes Production Tools, Inc.*, 984 F.2d 410, 415 (Fed. Cir. 1993); *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1206-07 (Fed. Cir. 1992), *cert. denied*, 113 S. Ct. 976 (1993); *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*, 945 F.2d 1546, 1549-50 (Fed. Cir. 1991); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579 (Fed. Cir. 1989); *Snellman v. Ricoh Co., Ltd.*, 862 F.2d 283, 287-88 (Fed. Cir. 1988), *cert. denied*, 491 U.S. 910 (1989); *Perini America, Inc. v. Paper Converting Machine Co.*, 832 F.2d 581, 584 (Fed. Cir. 1987); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir.), *cert. denied*, 469 U.S. 1037 (1984).

6. The Jury's Verdict, And The Denial Of U.S. Surgical's Motion For JMOL

After four days of deliberations, the jury returned a verdict. It found, *inter alia*, that all four of the claims on which U.S. Surgical sued would have been obvious to a person of ordinary skill in the art.

After the verdict, the U.S. Surgical moved for JMOL. Its principal argument was that, as a matter of law, the claimed invention would not have been obvious to a person of ordinary skill. The district court denied this motion. It found, *inter alia*, that the obviousness verdict was supported by substantial evidence, including evidence that the only points of difference between the invention and a generic multiple clip applier -- a long shaft and a seal -- were well-known, obvious features for *any* endoscopic instrument. Pet. at 20a-22a.

7. U.S. Surgical's Appeal

U.S. Surgical now tries to create the impression that its appeal in the Federal Circuit centered on the issue of whether the trial court erred in denying its request for an instruction construing the claims. That was not the case.

The question of who construes the claims, judge or jury, was a minor tangent in U.S. Surgical's appeal brief.[2] It was relegated to just a single paragraph in the "Argument" section of that brief, appearing *after* U.S. Surgical's main argument that the claimed invention was "Not Obvious As A Matter of Law" (App. A at A-1-6), and *after* its additional argument that a new trial was necessary because of alleged

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[2] The Argument section of U.S. Surgical's appeal brief is reproduced in full as Exhibit A hereto.

errors in the trial court's instructions on obviousness (*id.*, at A-6-9).

It is not surprising that U.S. Surgical stressed other points while de-emphasizing the issue of who construes the claims. After all, U.S. Surgical could not point to *any* prejudice from the denial of its request for an instruction directing the jury to the claim construction most likely to lead to a finding of obviousness.

When Ethicon pointed this out in its opposition brief on appeal, U.S. Surgical had no response. It was never able to articulate any way in which it was prejudiced by the denial of its proposed instruction construing the claims.

Upon consideration of U.S. Surgical's arguments, the Federal Circuit affirmed the judgment without opinion.

8. U.S. Surgical's Request That The Federal Circuit Rehear This Case *En Banc* Or, In The Alternative, Defer Decision Pending *Markman*

After the Federal Circuit's summary affirmance, U.S. Surgical grasped at the *Markman* straw. It did this in a Petition For Rehearing, With A Suggestion For Rehearing En Banc, which asked the panel, and the entire court sitting *en banc*, to re-hear this case because of two issues that were buried at the back end of its appeal brief: (a) a claim that U.S. Surgical was prejudiced by the trial court's submission of a standard dictionary to the jury; and (b) the issue of who construes the claims, which was then pending before the Federal Circuit *en banc* in *Markman*.

In the alternative, U.S. Surgical asked the Federal Circuit to "hold this case [in abeyance] until its issuance of an

opinion *en banc* in . . . *Markman*." (Suggestion For Rehearing En Banc at 14). Once again, U.S. Surgical could not identify any prejudice caused by the denial of its proposed instruction construing the claims.

U.S. Surgical's Petition for Rehearing and its Suggestion of Rehearing En Banc were summarily denied.

9. U.S. Surgical's Conspiracy Theory

To explain the result in the Federal Circuit, U.S. Surgical now conjures up a conspiracy involving two judges on the Federal Circuit. U.S. Surgical imagines that it lost on appeal because Judge Newman and Judge Rader were secretly determined "not to bow to their colleagues" who joined in the *Markman* majority (Pet. at 8), and decided instead to "impose their idiosyncratic views in a summary affirmance." (*Id.*, at 15-16).

This conspiracy theory is irresponsible and absurd. Judge Newman and Judge Rader have gone on record in expressing their reservations about the outcome in *Markman*. But the *Markman* issue had nothing to do with the outcome of this case, and was only a minor tangent in U.S. Surgical's appeal. The main themes in U.S. Surgical's appeal brief involved issues unrelated to *Markman*, including the sufficiency of the evidence of obviousness and alleged errors in the instructions on obviousness. *See* App. A at A-1-9.

Moreover, U.S. Surgical's Suggestion For Re-Hearing En Banc, which raised the *Markman* issue, was circulated to each of the eleven Federal Circuit judges in regular active service -- including the eight judges who joined in the

Markman majority.[3] It is telling that *not one* of the Federal Circuit's eleven judges was in favor of U.S. Surgical's suggestion for *en banc* re-hearing, and *not one* judge on the entire court was in favor of deferring this case pending a decision in *Markman*.

These facts refute U.S. Surgical's conspiracy theory. For good reason, all eleven of the Federal Circuit's active judges -- and not just Judge Newman and Judge Rader -- rejected U.S. Surgical's request to hold this case in abeyance until *Markman* was decided. If there was a conspiracy on the Federal Circuit to subvert the *Markman* decision, as U.S. Surgical imagines, it thus would seem to include not only Judge Newman and Judge Rader, but also Chief Judge Archer (who wrote the majority opinion in *Markman)*, each of the seven judges who joined in Chief Judge Archer's majority opinion, and Judge Mayer (who concurred in the result).

REASONS WHY THE WRIT SHOULD BE DENIED

I. This Case Does Not Present The Issue Presented By *Markman*

This Court should reject U.S. Surgical's attempt to bootstrap its petition to the petition for certiorari in *Markman v. Westview Instruments*. The issue presented by *Markman*, of whether claim construction is a fact issue for the jury or an issue of law for the judge, had no impact on this case. For

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[3] Rule 35, Fed. R. App., and Federal Circuit Rule 35 both require that a suggestion for rehearing *en banc* must be circulated not only to the members of the panel, but also to all judges on the court who are in regular, active service.

good reason, it was only a minor point in U.S. Surgical's appeal. That issue is not fairly presented by this case. Whether or not this Court grants certiorari in *Markman*, there is no reason to grant it here.

At trial, U.S. Surgical advocated the broadest claim construction possible, because a narrower construction would not have covered the Ethicon device. But as demonstrated above at pages 3-6, U.S. Surgical's broad construction of the claims virtually compelled a finding of obviousness. If anything, an instruction that directed the jury to U.S. Surgical's broad construction would have made the obviousness verdict all the more inevitable.

On appeal, U.S. Surgical's brief treated the issue of who construes the claims as a subsidiary point. That made perfect sense because U.S. Surgical could not identify any prejudice from the denial of an instruction directing the jury to its broad construction of the claims. The issue does not deserve more serious treatment now.

As part of its effort to bootstrap this case to *Markman*, U.S. Surgical argues that the record in this case would illuminate the issues in *Markman*. It suggests, for example, that its "comprehensive [proposed] instructions" interpreting the claims would provide this Court with an "invaluable aid" in deciding the issue presented by *Markman*. (Pet. at 13-14).

The record in *Markman*, however, presents that issue perfectly well on its own. That is why the Federal Circuit selected *Markman*, and not this case, as a vehicle for *en banc* consideration of the issue. The issues in *Markman* do not need to be illuminated by the record in this case.

Moreover, U.S. Surgical's "comprehensive instructions" were infected with basic errors of substantive

law. Among other things, U.S. Surgical's proposed instructions were inconsistent with settled law on how to construe "means-plus-function" elements under 35 U.S.C. §112(6).[4] Erroneous instructions would not aid in deciding *Markman* if certiorari is granted in that case.

II. There Is No Reason For This Court To Hold This Case In Abeyance Pending Action In *Markman*, Or To Supervise The Decision By The Eleven Active Judges On The Federal Circuit Not To Hold This Case In Abeyance Pending *Markman*

U.S. Surgical also asks this Court to hold this case in abeyance pending further action in *Markman*. Earlier, when the Federal Circuit was on the verge of issuing its *en banc* decision in *Markman*, U.S. Surgical made a similar request to the eleven active judges on the Federal Circuit. This Court should be guided by their unanimous response.

Not one of the Federal Circuit's eleven active judges voted to rehear this case in light of *Markman*. Moreover, *not one* of those eleven judges was in favor of deferring this action pending the soon-to-be-issued decision in *Markman*.

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[4] For example, U.S. Surgical's construction of means-plus-function elements erroneously disregarded the structure for performing particular functions, as described in the portion of the patent specification that discusses the preferred embodiments of the invention. That approach was error. *King Instruments Corp. v. Otari Corp.*, 767 F.2d 853, 862 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1016 (1986).

The denial of U.S. Surgical's request to hold this case in abeyance pending *Markman* was sound and sensible. As the Federal Circuit's eleven judges recognized, implicitly if not explicitly, the soon-to-be issued opinion in *Markman* would not in any way affect the result here. Indeed, the instruction that U.S. Surgical requested, directing the jury to its broad construction of the claims, would only have made the finding of obviousness all the more likely. *See*, pages 3 to 6, *supra*.

The timing of the Federal Circuit's refusal to defer a decision in this case pending *Markman* makes its views on that issue especially significant. *Markman* had been *sub judice* for more than ten months, but a decision in *Markman* was less than two weeks away at the time the Federal Circuit's eleven active judges denied U.S. Surgical's request to defer this case pending a decision in *Markman*. There is no greater reason to hold this case in abeyance now.

If this Court were to grant certiorari in *Markman* and review that case on the merits, there could be two possible outcomes. One possible outcome is that this Court might agree with the Federal Circuit's decision in *Markman*, and conclude that claim construction is invariably a question of law. But as eleven Federal Circuit judges have already implicitly recognized, this holding would not affect the result in this case -- because U.S. Surgical was not prejudiced in the slightest by the denial of a jury instruction construing the claims in the way most likely to lead to a finding of obviousness.

A second possible outcome if this Court grants certiorari in *Markman* is that this Court might agree with the *Markman* dissent, and conclude that claim construction may be submitted to the jury where it depends on facts that are genuinely in dispute. This outcome would also have no effect

on this case, because the trial court followed that approach here.

Either way, a decision on the merits in *Markman* would not affect the finding of obviousness in this case. In these circumstances, the Federal Circuit's decision not to defer this case pending *Markman* was appropriate in all respects. It presents no occasion for this Court's review.

III. The Federal Circuit's Decision Does Not Conflict With Precedent From Other Circuits On The Dictionary Issue

U.S. Surgical also asks this Court to grant certiorari to resolve a purported conflict on whether the trial court's submission of a standard dictionary to the jury requires a new trial. However, the Federal Circuit's summary affirmance is in harmony with the views of virtually every court that has considered this issue. As one court has stated:

> It appears to be the near universal consensus that a new trial is not awarded simply because a dictionary was before the jury.

Wernsing v. General Motors Corp., 470 A.2d 802, 806 (Md. 1984). This "near universal consensus," *id.*, is grounded in clear logic and common sense. "[T]he definition of words in our standard dictionaries is . . . a matter of common knowledge which the jury is supposed to possess." *State v. Asherman*, 193 Conn. 695, 478 A.2d 227, 252 (1984), *cert. denied*, 470 U.S. 1050 (1985). For this reason, the overwhelming majority of

courts have found nothing about the jury's exposure to a dictionary that requires a new trial.[5]

U.S. Surgical also purports to identify a conflict between the Federal Circuit's summary affirmance and *United States v. Weiss*, 752 F.2d 777 (2d Cir.), *cert. denied*, 474 U.S. 944 (1985), on the issue of whether the trial court should have been required to hold a hearing to determine how the jury used the dictionary. This argument misreads *Weiss*, and overlooks Rule 606(b), Fed. R. Evid., which precludes such a hearing.

In *Weiss*, jurors obtained access to *extraneous* material without the trial judge's approval. That was not the case here. Rather than being "extraneous," the dictionary was submitted to the jury in this case upon the direction of the trial judge. It was not "extraneous" in any meaningful sense. Rather, it was akin to evidence that the trial court admits over an objection or adduces on its own, when it calls and questions a witness not called by either side, as permitted by Rule 614, Fed. R. Evid.

Neither *Weiss* nor any other case applying the Federal Rules of Evidence permits a hearing on how jurors used

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[5] *See, e.g., United States v. Turner*, 936 F.2d 221, 226 (6th Cir. 1991); *United States v. Cheyenne*, 855 F.2d 566, 568 (8th Cir. 1988); *United States v. Steele*, 785 F.2d 743, 746 (9th Cir. 1986); *Copeland v. Gulf Oil Corp.*, 672 F.2d 867, 871-72 (11th Cir. 1982); *United States v. Duncan*, 598 F.2d 839, 866 (4th Cir.), *cert. denied*, 444 U.S. 871 (1979); *United States v. Gunter*, 546 F.2d 861, 869 (10th Cir.), *cert. denied*, 431 U.S. 920 (1977). *See also*, *Wernsing*, 470 A.2d at 806 (collecting cases).

material submitted to them on the trial judge's direction. [6] Indeed, Rule 606(b), Fed. R. Evid., expressly bars any inquiry into how jurors use material sent into the jury room by the trial court.[7]

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[6] The Federal Rules of Evidence were inapplicable in the state court cases that U.S. Surgical cites. The vast majority of those cases involved extraneous material, and were thus completely inapposite. Three cases were decisions from state supreme courts involving a trial court's submission of a dictionary to a jury. None of those cases is on point. *Smith v. State*, 95 So.2d 525, 527-28 (Fla. 1957), was decided under Florida statutes, not the Federal Rules. Similarly, *Creasey v. Hogan*, 637 P.2d 114, 122-25 (Ore. 1981), was decided under a an Oregon statute that has since been repealed. In addition, the judge in that case submitted a definition of highly specialized terms in a medical dictionary, which were not a matter of "common knowledge." *Compare* cases cited in fn. 9, *infra*. The third case, *Dongo v. Banks*, 448 A.2d 885, 888 (Me. 1982), affirmed the grant of a new trial as a permissible exercise of the "discretion of trial judge." Here, the trial judge also had "broad discretion," *Weiss*, 752 F.2d at 783, and did not abuse it in denying a new trial. *See*, page 18, *infra*.

[7] Rule 606(b) states as follows:

> Upon an inquiry into the validity of a verdict . . ., a juror may not testify as to any matter or statement occurring during the course of the jury's deliberations or to the effect of anything upon that or any other juror's mind or emotions as influencing the juror to assent or

Even assuming *arguendo* that the dictionary was "extraneous," it would have been improper under Rule 606(b) to hold a hearing on the "*effect* the outside information had upon [any] juror." *United States v. Simpson*, 950 F.2d 1519, 1521 (10th Cir. 1991) (emphasis in original). Under the Rule, the only possible issue in an evidentiary hearing was *whether* the jury was provided a standard dictionary by the trial court. Since that issue was not in dispute, a hearing would have been an "exercise in futility." *Id.*[8]

In its briefs and oral argument in the Federal Circuit, U.S. Surgical could not even present a credible hypothesis on how submission of the dictionary might have prejudiced it. In denying U.S. Surgical's motion for a new trial, the district judge carefully considered U.S. Surgical's arguments on possible

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> dissent from the verdict . . . or concerning the juror's mental processes in connection therewith, except that a juror may testify on whether extraneous prejudicial information was improperly brought to the jury's attention or was improperly brought to the jury's attention or whether any outside influence was improperly brought to bear on any juror. Nor may a juror's affidavit or evidence of any statement by the juror concerning a matter about which the juror would be precluded from testifying be received for these purposes.

[8] *Accord: United States v. Duncan*, 598 F.2d at 866 (affirming the denial of a new trial motion, and stating that because of the "limited inquiry permitted by Rule 606(b)," it would have been "futile" to hold a hearing on how jurors used a dictionary they obtained without the trial court's approval .).

prejudice. The district judge recognized, quite properly, that "'the definition of words in our standard dictionaries is taken as a matter of common knowledge which the jury is supposed to possess.'" (Pet. at 30a-31a, quoting *Asherman*, 478 A.2d at 252). He accordingly found that submission of the dictionary did not result in prejudice. *Id.* Even if the dictionary were "extraneous" within the meaning of Rule 606(b), this finding would not be an "abuse" of the trial judge's "broad discretion" in evaluating such matters.[9] *Weiss*, 752 F.2d at 783.

IV. There Is No Reason For This Court To Supervise The Federal Circuit's Application Of Rule 36, Fed.R.App.

U.S. Surgical's final argument is that this Court should grant certiorari to supervise the Federal Circuit's exercise of its authority to issue summary decisions. This authority derives

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[9] Even the injection of extraneous information into jury deliberations is deemed harmless where, as here, the information is merely "common knowledge." *See, Shillcutt v. Gagnon*, 827 F.2d 1155, 1159 (7th Cir. 1987) ("Jurors are expected to bring commonly known facts . . . to bear in arriving at their verdict."); *United States v. McKinney*, 429 F.2d 1019, 1022-23 (5th Cir. 1970), *cert. denied*, 401 U.S. 922 (1971) (same); *In re New York Asbestos Litigation*, 847 F. Supp. 1086, 1100 (S.D.N.Y. 1994) ("An expression of . . . 'general knowledge' does not qualify as 'extraneous prejudicial information' within the exception of Rule 606[b]."). *See also*, Vol. 3, *Weinstein's Evidence*, ¶ 6.06[4] at 606-44 (1995) ("Jurors are expected to bring commonly known facts to bear in assessing the facts presented for their consideration.").

from Rule 36, Fed. R. App., which explicitly states that courts of appeals may render their judgments "without an opinion."

Given the increasing burdens on appellate courts, there are "compelling reasons for the use of summary dispositions in appropriate cases," especially because "many cases do not present any new or significant issue . . . ." *Furman v. United States*, 720 F.2d 263, 266 (2d Cir. 1983). The use of summary opinions permits judges to separate wheat from chaff, and to "devote more time to the remaining cases that truly merit developed exercises of judicial craftsmanship." *Id.* Courts of appeals have broad discretion to determine whether a summary affirmance is appropriate in any given case. *Id.*, 720 F.2d at 265.

That discretion was appropriately exercised here. This appeal was just like many others where an appellee presents a series of meritless arguments to make up in quantity for the absence of any single argument that is sound. It was a perfect candidate for summary affirmance.

U.S. Surgical argues that the summary affirmance "swept presumptively prejudicial error [on the dictionary issue] under the rug." Pet. at 21. But as discussed in Point III, *supra*, the district court's decision on the dictionary was neither error nor prejudicial.

Moreover, the main arguments in U.S. Surgical's appeal brief, including its objections to the sufficiency of the evidence and its list of alleged errors in the instructions on obviousness, *see* App. A at A-1-9, were also devoid of merit. U.S. Surgical does not, and cannot, find fault with the Federal Circuit's rejection of these arguments in a summary affirmance. Nothing about the summary affirmance warrants this Court's review.

CONCLUSION

For the reasons set forth above, this Court should deny U.S. Surgical's petition for a writ of certiorari.

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APPENDIX

IV. ARGUMENT

A. U.S. Surgical's '420 and '057 Inventions Were Not Obvious As A Matter Of Law

This Court reviews the legal conclusion of obviousness de novo; any underlying factual determinations must be reversed where unsupported by substantial evidence. Structural Rubber, 749 F.2d at 718-19, 223 USPQ at 1272-73; In re Donaldson Co., 16 F.3d 1189, 1192, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (en banc). An obviousness verdict must be overturned unless supported by clear and convincing evidence. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1565-66, 1 USPQ2d 1593, 1594-95 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987). The infringer must prove clearly and convincingly that the claim as a whole -- interpreting each means-plus-function element in light of the structures described in the specification -- would have been obvious to one of ordinary skill. Donaldson, 16 F.3d at 1193, 29 USPQ2d at 1848-49; Gillette Co. v. S.C. Johnson & Son, Inc., 919 F.2d 720, 724, 16 USPQ2d 1923, 1927 (Fed. Cir. 1990).

Ethicon failed to provide any evidence that the claims at issue, taken as a whole and interpreted in light of the structures described in the specification, would have been obvious. Rather, Ethicon's evidence focused on the "concept" of an endoscopic multiple clip applier, and sought to persuade the jury that this concept was obvious.[1] In the absence of any

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[1] The record on this point is clear: Ethicon's witnesses -- mechanical expert Mann and engineer Love -- could testify only that the "concept," not the claimed invention, was obvious. *See* A. 583 (Tr. 2246-48); A. 520

evidence that the claims as a whole would have been obvious, the issue was never a jury issue. The jury, with no factual basis, and per force in the absence of evidence that was clear and convincing, simply ignored and overrode the presumption of validity.

1. The Prior Art Did Not Teach or Suggest

In its post-trial opinion, the District Court, invoking this Court's decision in Ashland Oil, Inc. v. Delta Resins & Refactories, Inc., 776 F.2d 281, 293, 297 & n. 24, 227 USPQ 657, 667 & n. 24 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986), accurately described the first prong of the "obviousness" standard, namely, "that the prior art would have taught or suggested, to the person of ordinary skill, the combination of individual elements found in the patented device . . . ." A. 22.

Here, the parties' own conduct demonstrates that no such showing was remotely possible. U.S. Surgical was way ahead of the art. In 1985, it conceived of an endoscopic multiple clip applier which it believed would have application in general surgery. In 1987, it began serious design and engineering efforts, including initial model making. By contrast, when Ethicon first began to think about an endoscopic clip applier in 1989, it thought in terms of importing a single clip applier from a European affiliate[2] -- which is what the prior art did teach to one of ordinary skill. As of the date U.S. Surgical filed its '420 patent application, Ethicon was still working on its Gen-II open multiple clip applier with a ratchet feed system to compete with U.S.

(Tr. 1892).

[2] See n. 14, supra.

Surgical's Premium Surgiclip. Ethicon did not consider developing an endoscopic multiple clip applier until after the October 1989 ACS Convention, until after it had obtained and examined U.S. Surgical's ENDO CLIP, and until it had observed the ENDO CLIP's remarkable commercial success.

By July 1989, when U.S. Surgical applied for its '420 patent, multiple clip appliers for open surgery and endoscopic single clip appliers had co-existed for a decade. Nothing in the prior art suggested or taught the claimed endoscopic multiple clip applier. No one had made an endoscopic multiple clip applier, and no one was motivated to try except, of course, U.S. Surgical. U.S. Surgical alone had foreseen the desirability and need for an endoscopic multiple clip applier. It was clear that, given these circumstances and this prior art, it simply was not obvious to a person of ordinary skill in the art to try to make the claimed invention when U.S. Surgical applied for its patent in 1989. See, e.g., In re Shaffer, 229 F.2d 476, 480, 108 USPQ 326, 329 (C.C.P.A. 1956) (non-obviousness supported where problem that invention addressed "was not recognized in the prior art," and problem was "heretofore unknown").

In reaching out for evidence that might sustained the jury's verdict, the District Court relied on Polk '239, and endoscopic device that applied elastic loops to fallopian tubes, as giving "suggestion, incentive, or motivation to make the claimed invention." A. 24 at n. 20.[3] Ethicon's mechanical

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[3] The Polk applicator applies rubber rings which are manually stretched onto the extension of the device. A. 763-64 (col.5, lines 1-4; col. 7, lines 50-58). These structures are completely different from the claimed clip applier. The ring closes by itself through elastic memory

expert, Professor Mann, admitted, however, that this reference taught *away* from the claimed invention; it did not relate to surgical clips and was not useful for ligating arteries and vessels. A. 582 (Tr. 2241-42). The reference not only fails to support the verdict but, in fact, is inconsistent with it.

2. The Prior Art Did Not Show How To Obtain The Desired Result

In its post-trial opinion, the District Court, invoking this Court's decision in In re Eli Lilly & Co., 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990), accurately described the second prong of the "obviousness" standard, namely, "that the prior art would sufficiently teach or direct one of ordinary skill 'how to obtain the desired result." A. 22; see also Gillette, 919 F.2d at 724-25, 16 USPQ2d at 1928.

The testimony of Ethicon mechanical expert Mann and its engineer Love that U.S. Surgical's invention was not obvious and was difficult to do, as set forth at pp. 16-17, supra, proves that no engineer of ordinary skill based on the prior art would enjoy a reasonable likelihood of success at making the '420 and '057 invention -- which must be dimensioned to work through a standard trocar, as recited in the '420 specification. A. 144 (col. 4, lines 12-16).

In the numerous drawings and detailed specification of its patents, U.S. Surgical enabled persons of ordinary skill to make an (efficacious) endoscopic multiple clip applier. U.S. Surgical set out its choices, including its

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and is not closed by any action of the device itself. A 764 (col. 8, lines 8-16, 27-31). The Polk applicator is not a hemostatic ligating device. A. 642-43 (Tr. 2565-66).

selection of an appropriate clip storing system, clip advancing system, clip closing system, and sealing system, and its patent claims reflect these choices. Donaldson, 16 F. 3d at 1193, 29 USPQ2d at 1848-49. By contrast, in July 1989, when U.S. Surgical applied for the '420 patent, Ethicon was pursuing alternative choices, including an inappropriate clip advancing system (a ratchet) for a thin profile, multiple clip applier for open surgery. Given the state of Ethicon's own clip applier art, it is no wonder that Ethicon's witnesses had to concede that the prior art did not show how to obtain the '420 and 057 inventions. A. 520 (Tr. 1892); A. 583 (Tr. 2246-48).

In its post-trial opinion, the Court asserted in note 22 that "the testimony of experts and inventors" provided substantial evidence to support the jury's finding, but the Court did not refer in the record to what it had in mind. A. 25. It was not allowed, of course, to rely on the testimony of any U.S. Surgical inventor in place of the hypothetical person of ordinary skill. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc., 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987), Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 454, 227 USPQ 293, 297-98 (Fed. Cir. 1985). And Ethicon's mechanical expert, Professor Mann, supported U.S. Surgical's position, not Ethicons. A. 583 (Tr. 2246-48).

There is no arguable basis in the record for the jury's finding that the prior art taught an engineer of ordinary skill how to make an efficacious endoscopic multiple clip applier at the time of U.S. Surgical's invention.

3. Second Considerations Strongly Support Non-Obviousness

The secondary consideration of commercial success is rearly as evident in this case. U.S. Surgical's ENDO CLIP

was a huge commercial success due to its patented features, and the same was true of the infringing EMCA/ERCA. See pp. 12-13, 21, supra. The commercial success of these novel products strongly supports the legal conclusion of non-obviousness. Minnesota Mining and Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1575, 24 USPQ2d 1321, 1335 (Fed. Cir. 1992); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1053, 5 USPQ2d 1432, 1440 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

4. No Evidence Overcomes The Presumption Of Validity

This Court should rule that the claims at issue were not obvious as a matter of law when, as here, the ENDO CLIP was the first endoscopic multiple clip applier; the relevant prior art co-existed for a decade before the invention, the Examiner considered the most relevant prior art during prosecution of the patents, and the claims at issue are presumptively valid over the prior art; no prior art suggested the claimed combination; the infringer's own mechanical expert and senior engineer acknowledged that U.S. Surgical's invention was not obvious and was difficult to do; and the infringer conceded that the invention was an enormous commercial success due to its patented features.

B. Alternatively, Prejudicial Deficiencies In Obviousness Instructions Require a New Trial

The Court "review[s] the adequacy of the jury instruction for prejudicial legal error." Mendenhall v. Cedarapids, Inc., 5 F.3d 1557, 1563, 28 USPQ2d 1081, 1087 (Fed. Cir. 1993), cert. denied, 114 S. Ct. 1540 (1994); see also Jamesbury Corp. v. Litton Indus. Producs. Inc., 756 F.2d 1556, 1558 225 USPQ 253, 255 (Fed. Cir. 1985).

In this case, U.S. Surgical's ENDO CLIP invention was left to an unguided and misled jury. The District Court stood by while Ethicon, the infringer, repeatedly stressed improper and prejudicial themes -- e.g., that the U.S. Surgical invention was "easy" and therefore obvious; that the presumption of validity was weakened because U.S. Surgical withheld the Premium Surgiclip '226 patent from the Patent Office notwithstanding Judge Eginton's contrary and correct ruling that the '226 patent was cumulative and not material; that the absence of certain "secondary considerations" supported a finding of obviousness; that prior art that teaches away from an invention can support a finding of obviousness; and, perhaps most egregious of all, that enforcement of U.S. Surgical's patents hindered competition, requiring a verdict in Ethicon's favor. The District Court failed to rein in Ethicon's counsel and, to compound the problem, refused to construe the meaning of the claims for the jury, despite the fact that the claim language was clear and all of the relevant terms were well-defined in the specification. The Court's failure to give critical curative and other instructions was of crucial importance in defending against the infringer's claim of obviousness, and seriously prejudiced U.S. Surgical.

○ No "Manner of Invention" Instruction: The Court's refusal to instruct in terms of the last sentence of 35 U.S.C. § 103 is not defensible. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1547, 220 USPQ 193, 198 (Fed. Cir. 1983) (obviousness "instructions should track the statute, 35 U.S.C. § 103"); Shiley, Inc. v. Bentley Lab. Inc., 794 F.2d 1561, 1568, 230 USPQ 112, 115-16 (Fed. Cir. 1986) (jury "correctly instructed that patentability of an invention does not depend on how the invention was made"); S. Rep. No. 1979, 82d Cong., 2d Sess. 18 (1952), reprinted in 1952 U.S.C.C.A.N. 2411 (statutory language means it is "immaterial whether [invention] resulted from long toil and experimentation or from a flash of genius"). See pp. 22-23,

supra. The absence of such an instruction was particularly prejudicial in light of Ethicon's heavy reliance throughout trial and in closing on U.S. Surgical's alleged "ease" of invention. This error was especially grievous because the Court's refusal to correct Mr. Ryther's wrong legal construction, *see* pp. 22-23, supra, left the jury with the misimpression that Ethicon was correct that the manner of invention could negative patentability.

- No "'226 Patent As Cumulative" Instruction: The Court's refusal to give an instruction that the Premium Surgiclip '226 patent was cumulative, in accordance with the inequitable conduct summary judgment ruling in U.S. Surgical's favor, was also grave because the '226 patent was not brought to the attention of the Examiner, see pp. 23-24, supra, had the effect, without a curative instruction, of wrongly undercutting the statutory presumption of validity. See W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983) (prior art not before the Examiner that is "merely pertinent" does not make the burden of proving invalidity easier to overcome), cert. denied, 469 U.S. 851 (1984).

- No "Absence of Secondary Considerations" Instruction: The Court's refusal to instruct the jury that the absence of secondary considerations was a neutral factor that was in no way probative of non-obviousness was serious error. E.g., Medtronic, Inc. v. Intermedics, Inc., 799 F.2d 734, 739 & n. 13, 230 USPQ 641, 643 & n. 13 (Fed. Cir. 1986), cert. denied, 479 U.S. 1033 (1987); Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d955, 960, 1 USPQ2d 1196, 1199 (Fed. Cir. 1986). In the absence of appropriate instruction, Ethicon was permitted to undermine improperly the undisputed "commercial success" of the ENDO CLIP as a secondary consideration favoring non-obviousness. See pp. 24-25, supra. It wrongly penalized U.S.

Surgical for being so far ahead that there were no long-felt need or attempts by others because no one was even working in the area. See Uniroyal, 837 F.2d at 1053, 5 USPQ2d at 1440 ("Even though demand increased after the oil crisis, the court overlooked the fact that it was the claimed invention to which the industry turned, and it was the uniqueness of the claimed invention which made this so").

○ No "Taught Away" Instruction: The Court's refusal to give the jury a "taught away" instruction, in light of Ethicon's reliance on prior art that actually taught away (e.g., Polk '239, A. 755), was also serious error, since such evidence, see p. 25, supra, can be an important indicator of non-obviousness. E.g., In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988).

○ No "Meaning of Claims" Instructions: The Court's refusal to instruct the jury on the meaning of the patent claims necessarily prejudiced the jury's consideration of obviousness. *Genentech*, ___ F.3d ___, 31 USPQ2d at 1165, 1172 & n. 47 (error to "fail[] to instruct the jury on the proper claim construction it was to apply"); Read 970 F.2d at 822 & n. 3, 23 USPQ2d at 1432 & n. 3. In this case, Ethicon argued that, if the accused devices infringed, then U.S. Surgical's claims covered the broadest of structures, such as any jaws or any seal means, and that the claims were therefore obvious. See, e.g., A. 578 (Tr. 2214); A. 598 (Tr. 2325-26); A 672-73 (Tr. 2708-09). This portrayal of the claims completely ignored the specific limitations in the patent claims and specification, and for which U.S. Surgical had sought specific instructions. A. 81-97, 101-09; A. 578 (Tr. 2214). Failure to give such instruction was highly prejudicial error when, as here, the infringer's obviousness defense turned on an abusive misreading of the patent claims. See *Beachcombers, Int'l, Inc. v. Wildewood Creative Products*, No. 93-1258, 1994 U.S. App. LEXIS 19881, at *15 (Fed. Cir. Aug. 3, 1994) ("first

step in [obviousness analysis] involves the proper interpretation of the claims"); Smithkline Diagnostics, Inc. v. Helena Lab. Corp., 859 F.2d 878, 885, 8 USPQ2d 1468, 1474 (Fed. Cir. 1988); Panduit, 810 F.2d at 1576, 1 USPQ2d at 1603 ("[w]hen the prior art is compared with erroneously interpreted claims, findings of differences between the prior art and the claims will necessarily be clearly erroneous").

o No Curative Instruction Regarding Competition: The District Court, despite promising to deal with Ethicon's policy argument for competition notwithstanding the patent law, never did so. Defense counsel at every turn, from opening to closing, in examination and cross-examination, including repetition of blatantly improper question on which objection had been previously sustained, made competition the centerpiece of Ethicon's defense. See pp. 26-28, supra. The peroration in closing to "honor competition" was an appeal for jury nullification. A. 673 (Tr. 2710). This Court fully appreciates the argument to this effect in a jury case is a "serious impropriety," likely to be prejudicial," and warrants a curative instruction. Jamesbury, 756 F.2d at 1559, 225 USPQ at 255. Since Ethicon's argument that it be allowed to sell its infringing products in the name of competition was the main theme of its defense, the resulting prejudice was as unfortunate and as extreme as can be found in a patent trial record. Eli Lilly & Co. v. Premo Pharmaceutical Labs, Inc., 630 F.2d 120, 138 (3d Cir.) ("Congress has determined that it is better for the nation in the long-run to afford the inventors of novel, useful, and non-obvious products short-term monopolies on such products than it is to permit free competition in such goods"), cert. denied, 449 U.S. 1014 (1980); Smith Int'l Inc. v. Hughes Tool Co., 718 F.2d 1573, 1577-78, 219 USPQ 686, 689-90 (Fed. Cir.), cert. denied, 464 U.S. 996 (1983).

The deficiencies in "obviousness" instructions, individually and together, and in combination with the Court's failure to control Ethicon's competition theme, deprived U.S. Surgical of its right to an "informed and . . . fair verdict []," Structural Rubber, 749 F.2d at 713, 223 USPQ at 1268 (emphasis in original), and clearly require a new trial on obviousness.

C. Submission Of The Dictionary Requires A New Trial On Obviousness

The District Court's provision of dictionary to the jury for use in its deliberations is reviewed by this court to determine whether its submission was presumptively prejudicial and here, since the presumption was unrebutted, necessarily requires a new trial. United States v. Weiss, 752 F.2d 777, 782-83 (2d Cir.), cert. denied, 474 U.S. 944 (1985).

When the District Court provided the jury with Webster's New World Dictionary over the objection of both parties, it created a presumption of prejudice following from the exposure of the jury to extraneous none-record material under the applicable law of the Second Circuit. Weiss, 752 F.2d at 782-83[4] Ethicon did not rebut this presumption of prejudice. The District Court therefore had two choices: it

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[4] The District Court's provision of the dictionary to the jury raises procedural issues not within the Court's unique jurisdiction. In such circumstances, this Court has held that the controlling law is that of the regional circuit in which the case was tried. Biodex Corp. v. Loredan Biomedical, Inc., 946 F.2d 850, 855-58, 20 USPQ2d 1252, 1256-59 (Fed. Cir. 1991), cert. denied, 112 S. Ct. 2957 (1992).

could set aside the jury verdict or, if it wanted to ascertain whether there was in fact prejudice, it could hold a hearing as requested by U.S. Surgical. It did neither.

The District Court's denial of U.S. Surgical's new trial motion on this point deprived U.S. Surgical of the presumption of prejudice mandated by the Second Circuit. The District Court assumed that the jury used the dictionary to discover the ordinary meaning of words used in the patent claims. A. 34. If so, the jury's use of the dictionary elegantly underscores the Court's own failure to define the meaning of the claims, with its prejudicial impact on the jury's consideration of "obviousness ," as already discussed, pp. 43-44, supra. It is equally likely that the jury also used the dictionary to look up the meaning of words such as "presumption" (as used in "presumption of validity"), "obviousness," or some other word laden with legal content in the patent world. Structural Rubber, 749 F.2d at 723, 223 USPQ at 1276. The whole reason that prejudice is presumed from a jury's consideration of such extraneous matter is precisely to avoid such speculation. Stiles v. Lawrie, 211 F.2d 188, 190 (6th Cir. 1954).

The District Court justified its submission of the dictionary to the jury by assuming that its use accorded with the standard instruction in patent cases to consider the "ordinary meaning" of claim language as interpreted by one of ordinary skill in the art. A. 34; A. 676-77 (Tr. 2732-33). Such reasoning must be of particular concern to this Court. Inevitably, giving a jury a dictionary will deprive the patentee of his right to be his own lexicographer, will override a trial court's definition of terms in its own instructions, and is also inconsistent with the requirement that the meaning of a claim be as understood by a person of ordinary skill in the art, not a lay jury with a standard dictionary. Absent a clear holding rejecting the District Court's rationale, this impermissible and

presumptively prejudicial practice will repeat itself to the complete debasement of a fair patent trial, as occurred below.

The District Court's placing of the burden to show prejudice on U.S. Surgical was but a denial of the clear law of the Second Circuit. Since Ethicon did not rebut this presumption of prejudice, this Court has no alternative under the applicable law of the Second Circuit but to order a new trial if it cannot determine '420 validity as a matter of law.

D. The Accused Devices Infringe Claims 1, 2 and 7 Of The 057 Patent As A Matter Of Law

A determination of the scope and meaning of a claim is a question of law that is review de novo. Read, 970 F.2d at 821, 23 USPQ2d at 1431; North American Vaccine, Inc. v. American Cyanamid Co., 7 F.3d 1571, 1575, 28 USPQ2d 1333, 1336 (Fed. Cir. 1993). This Court reviews the jury's verdict of non-infringement, assuming proper claim construction, for substantial evidence. Genentech ___ F.3d at ___, 31 USPQ2d at 1165 n. 6, 1168-69; Read 970 F.2d at 821, 23 USPQ2d at 1431.

In light of the '420 infringement finding, the only possible infringement issue on appeal relates to clip advancing means. Ethicon argued below that the EMCA/ERCA's clip advancing structure was not the same as or equivalent to that covered in '057 claim elements 1(b)(ii) and 7(b)(iii), because: its pusher bar was wider or stiffer than the pusher bar in the patent specification and performed the additional function of assisting in holding a clip in the jaws; it had a single upstanding tab, the so-called "primary valve," as an escapement means as opposed to the two upstanding tabs disclosed in the patent specification; and its clip advancing system included additional structure not found in the patent

specification -- clips were in two planes with a "lifter spring" to assist the clip on its path to the jaws after it had moved past the escapement tab. A. 564-65 (Tr. 2143-46); A. 557-58 (Tr. 2099-2107); A. 566 (Tr. 2154-56). All of these arguments, however, ignore the definition in the patent specification for clip advancing means as a longitudinally slidable pusher bar/escapement system, structure that found in the EMCA/ERCA and that Ethicon chose for the clip advancing from among other available alternatives. A. 170 ('057 patent, col. 3, lines 42-51); A. 498-99 (Tr. 1778-84); A. 512-13 (Tr. 1855-57).

The fact that additional structure is employed in the course of advancing clips to the jaws after the escapement or that the pusher performs a function in addition to clip advancing merely reflects that the accused devices have added features; it does not take the accused devices outside claim elements 1(b)(ii) and 7(b)(iii). See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 945, 15 USPQ2d 1321, 1332 (Fed. Cir.) ("The addition of features does not avoid infringement, if all the elements of the patent claims have been adopted. Nor is infringement avoided if a claimed feature performs not only as shown in the patent, but also performs an additional function") (citation omitted), cert. denied, 498 U.S. 920 (1990). Nor does the claim language limit the pusher bar or escapement to a specific shape or size. Based on the prior art, one-tab and two-tab escapement to a specific shape or size. Based on the prior art, one-tab and two-tab escapement structures were clearly recognized to be structurally equivalent. A. 342 (Tr. 910-14). To permit the accused EMCA/ERCA to escape infringement by changing the size or shape of the pusher bar or by joining the points of two upstanding tabs to make a one-tab escapement trivializes the

'057 patent and deprives U.S. Surgical of deserved and necessary protection.[5]

Careful patent drafters writing means-plus-function claims define the "means" in the specification. Genentech, ___ F.3d at ___, 31 USPQ2d at 1167-68; Donaldson, 16 F.3d at 1195-96, 29 USPQ2d at 1850-51. The defination then sets out the scope of the patent grant as to that means. There is no principled argument for honoring the definition in the specification. Beachcombers, 1994 U.S. App. LEXIS 19881, at* 8-9; Genentech Inc., ___ F.3d at ___, 31 USPQ2d at 1167-68, 1170; McGill, Inc. v. John Zink Co., 736 F.2d 666, 674, 221 USPQ 944, 949-50 (Fed. Cir. 1984); cf. D.M.I., Inc. v. Deere & Co., 755 F.2d 1570, 1572-73, 225 USPQ 236, 237-38 (Fed. Cir. 1985). Here, the clip advancing means in the '057 patent was defined in the specification as a pusher bar and an escapement means, which consisted of a plurality of upstanding tabs. A. 170 (col. 3, lines 42-51). If this Court applies the definition of clip advancing means contained in the '057 specification, it is clear that the accused devices literally infringe claim 1, as they have the same (pusher bar) and equivalent (one escapement tab for two tabs) structure, A. 498-99 (Tr. 1780-84); A. 586 (Tr. 2264-66); A. 590 (Tr. 2279-80); hence dependent claims 2 and claim 7 of the '057 patent are also infringed.

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[5] The jury rejected a similar argument when it found the EMCA/ERCA to infringe '420 claim 1, despite Ethicon's argument that it escaped infringement because its jaws were narrower than the ENDO CLIP's jaws and could fit down a 10 mm trocar without compressing.

Since the accused devices have all the means and structures recited in the '057 claims at issue, this Court should rule that they infringe as a matter of law.

E. Alternatively, This Court Must Order A New Trial on '057 Infringement

This Court reviews the adequacy of jury instructions, taken as a whole, for prejudicial legal error. See p. 40, supra. The District Court refused to construe the meaning of the key terms of the '057 patent for the jury, contrary to the clear law of this Court. Genentech, ___ F.3d at ___, 31 USPQ2d at 1165 n. 6, 1172 n. 47; Read, 970 F.2d at 822-23 & n. 3, 23 USPQ2d at 1432 & n. 3; Johnston v. IVAC Corp., 885 F.2d 1574, 1579, 12 USPQ2d 1382, 1385-86 (Fed. Cir. 1989). It rejected U.S. Surgical's jury instructions which set forth the meaning of the patent terms. U.S. Surgical was plainly prejudiced by the submission of unconstrued claims to the jury, and a new trial is therefore required. Genentech, ___ F.3d at ___, 31 USPQ2d at 1165, 1172 n. 47.

F. In Addition, Submission Of The Dictionary Requires A New Trial On '057 Infringement

For the same reasons that submission of the dictionary to the jury requires a new trial on "obviousness," it also requires a new trial on '057 infringement. See, pp. 45-47, supra.